

**Remarks/Arguments**

Entry of the present amendment is respectfully requested. It is earnestly believed that the present amendment places the above-identified application in a condition for allowance and, thus, entry of the present amendment is clearly appropriate.

By the present amendment, claims 1, 3-4, 11, 18, 25, 39 and 41 have been amended. Claims 49-61 have been added. Claims 2, 7-10, 19-20, 22-24, 40, and 42-43 have been canceled. The allowance of claims 12-17, 26-38, and 44-48 is noted.

Claims 1 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,575,754 to Konomura. Claim 18 also stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,530,880 to Pagliuca. Claim 21 stands rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,530,880 to Pagliuca. Claim 39 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,854,301 to Nakajima.

Claims 2, 7-10, 19-20, 22-24, 40, and 42-43 were objected to as depending from a rejected claim and were indicated as being allowable if rewritten in independent form. Accordingly, claims 49-61, which correspond to claims 2, 7-10, 19-20, 22-24, 40, and 42-43 rewritten in independent form, are allowable.

Claims 3-6 depend from claim 49 and are allowable for the specific recitations therein and for the same reasons as claim 49.

Claim 11 depends from claim 53 and is allowable for the specific recitations therein and for the same reasons as claim 53.

Claim 25 depends from claim 58 and is allowable for the specific recitations therein and for the same reasons as claim 58.

Claim 41 depends from claim 59 and is allowable for the specific recitations therein and for the same reasons as claim 59.

It is respectfully submitted that claims 1, 18, 21, and 39 are allowable. Specifically, claim 1 recites an apparatus for supporting an endoscope that extends through a cannula for viewing a surgical site in a patient during surgery on the patient including a base having means for associating the base with the cannula. The base has a guide portion. A first part is adapted to be fixed to the endoscope. A second part engages the guide portion and is movable relative to the guide portion. The first and second parts are movable together relative to the guide portion. A mechanism is connected between the base and the second part for moving the first and second parts relative to the guide portion to change a position of the endoscope relative to the cannula and the patient. None of the prior art describes or suggests an apparatus as set forth in claim 1.

U.S. Patent No. 5,575,754 to Konomura describes an endoscopic apparatus having a retaining section 14 with a fixing screw 40 that can be screwed into a port 7 of a jet engine 6. A slide member 15 extends into a through hole 14a in the retaining section 14. A cylindrical fixing member 20 is rotatably fitted in a portion 15b of the slide member 15. A pin 22 fixed to

the portion 15b of the slide member 15 extends into a groove 21 in the fixing member 20. The endoscope 1 passes through passages in the slide member 15, the fixing member 20 and the retaining section 14. The endoscope 1 is fixed to the fixing member 20 by a fixing ring 23. A rack 16 on a portion 15a of the slide member 15 meshes with a pinion 17 attached to the retaining section 14.

The Konomura patent does not describe or suggest an apparatus for supporting an endoscope that extends through a cannula for viewing a surgical site in a patient during surgery on the patient. The Konomura patent describes an endoscopic apparatus for supporting an endoscope that does not extend through a cannula for use with a jet engine. Furthermore, the Konomura patent does not describe or suggest a base having means for associating with a cannula. The retaining section 14 disclosed in the Konomura patent has a fixing screw 40 that is screwed into a port 7 of a jet engine 6. Also, the Konomura patent does not describe or suggest a mechanism for moving first and second parts relative to a guide portion to change a position of an endoscope relative to a cannula and a patient.

The Office Action states that the intended use of a device cannot define structurally over a prior art structure, especially when the prior art structure is capable of such intended use. It is respectfully submitted that functional language in a claim must be considered. The Court of Customs and Patent Appeals in In re Land gave patentable weight to functional

portions of claims by stating that the court does not regard the fact that portions of a claims are functional as a good ground to give them “no weight”. In re Land, 151 USPQ 621 (C.C.P.A. 1966). Furthermore, the Court of Appeals for the Federal Circuit in In re Mills gave patentable weight to functional limitations in a claim to find the claim patentable over the prior art. In re Mills, 16 USPQ2d 1430 (CAFC 1990). Accordingly, functional language must be considered.

It is respectfully submitted that the Konomura patent does not describe or suggest that the endoscopic apparatus is capable of being used to support an endoscope that extends through a cannula for viewing a surgical site in a patient during surgery. The endoscope described in the Konomura patent does not extend through a cannula. The endoscopic apparatus described in the Konomura patent has a threaded connection with a port 7 in a rigid metal housing of a jet engine. A jet engine and a patient are substantially different. A jet engine has a rigid metal outer housing and a patient has a flexible outer skin.

The Office Action also states that the language “for association with the cannula” is a functional recitation. As discussed above, functional language must be considered. Presently amended claim 1 recites means for associating with a cannula. The Konomura patent does not describe or suggest a base having means for associating with a cannula. Accordingly, claim 1 is allowable.

Claim 18 recites an apparatus for supporting an endoscope for viewing a surgical site in a patient during surgery on the patient. The endoscope extends through a cannula into the patient. The apparatus includes a base for supporting the endoscope extending through the cannula into the patient. A sleeve has means for receiving the cannula. The base and the sleeve are relatively rotatable about an axis of the cannula. A sleeve retainer supports the sleeve and the base. The sleeve retainer includes a member press fit axially onto an end portion of the sleeve. None of the cited prior art describes or suggests an apparatus as set forth in claim 18.

As discussed above, the Konomura patent does not describe or suggest an apparatus for supporting an endoscope for viewing a surgical site in a patient during surgery on the patient with the endoscope extending through a cannula into the patient. The Konomura patent describes an endoscopic apparatus for use with a jet engine. Furthermore, the Konomura patent does not describe or suggest a base for supporting an endoscope extending through a cannula into a patient. The Konomura patent describes an endoscope that does not extend through a cannula and extends into a jet engine. Also, the Konomura patent does not describe or suggest a sleeve having means for receiving a cannula. The fixing member 20 described in the Konomura patent, which is referred to as a sleeve in paragraph 5 of the Office Action dated August 13, 2003, has an endoscope passage 20a through which an endoscope 1 extends. A

cannula is not received in the passage 20a. The Konomura patent does not describe or suggest a sleeve retainer including a member press fit axially onto an end portion of a sleeve. The Konomura patent describes a pin 22 fixed to a slide member 15, which is referred to as a sleeve retainer in paragraph 5 of the Office Action dated August 13, 2003, and extending radially into a groove 21 in a sleeve or a fixing member 20 that is rotatable relative to the slide member and the pin. Accordingly, the pin 22 disclosed in the Konomura patent is not axially press fit into the groove 21 in the fixing member 20 since the fixing member moves relative to the pin. Furthermore, the pin 22 extends radially into the groove 21.

U.S. Patent No. 6,530,880 to Pagliuca describes an apparatus 10 for supporting an endoscope 200 for viewing a surgical site in a patient during surgery on the patient. The endoscope 200 extends through a cannula 11. A base 118 includes a base portion 120 having a first platform or disk 124 and a second understructure or disk 125 formed as one piece with the first platform or disk 124. An aperture 126 extends through the disks 124 and 125. A sleeve part 800 is secured to a cannula clamp 180 and is located in the aperture 126. A proximal end 22 of the cannula 11 can be inserted into and removed from the sleeve part 800. A radially extending ball plunger 400 secures the sleeve part 800 to the base 118, the base portion 120, and the first and second disks 124 and 125. The ball plunger 400 includes a spherical detent member 420 in a radial bore 127b in the base 118. The detent member 420 is radially movable relative to the

base 118 and extends into a recess 816 in the sleeve part 800 to form an indexing mechanism that secures the sleeve part 800 at selected angular increments relative to the base 118, the base portion 120, and the first and second disks 124 and 125. Accordingly, the disk 125 moves relative to the sleeve part 800 and the detent member 420 may be easily removed from the recess 816 in the sleeve part 800.

The Pagliuca patent does not describe or suggest a sleeve retainer for supporting a sleeve and a base and including a member press fit axially onto an end portion of a sleeve. The detent member 420 described in the Pagliuca patent is not axially press fit onto an end portion of the sleeve part 800. The detent member 420 extends radially into a recess 816 in the sleeve part 800. Thus, claim 18 is allowable.

Claim 21 depends from claim 18 and is allowable for the specific recitations therein and for the same reasons as claim 18.

Claim 39 recites an apparatus for supporting an endoscope for viewing a surgical site in a patient during surgery on the patient. The endoscope extends through a cannula into the patient. The apparatus includes a base for supporting the endoscope extending through the cannula into the patient. A sleeve has means for engaging an outer surface of the cannula. The base and the sleeve are relatively rotatable about an axis of the cannula. The sleeve has an internal diameter that increases from an initial diameter as the cannula is inserted into the sleeve and that subsequently springs back toward the initial diameter so that the

sleeve grips the cannula. None of the cited prior art describes or suggests an apparatus as set forth in claim 39.

U.S. Patent No. 4,854,301 to Nakajima describes an endoscope holding apparatus 181. A rotary frame 187 holding an endoscope 107 is rotatably fitted in a receiving frame 188. A rubber member 190 is provided on the inside surface of the rotary frame 187 to hold a large width operating part 112 of the endoscope 107 by friction. The rubber member 190 does not engage a cannula.

The Nakajima patent does not describe or suggest a sleeve having means for engaging an outer surface of a cannula through which an endoscope extends. The rubber member 190 described in the Nakajima patent engages a large width operating part 112 of an endoscope 107 and not a cannula. As discussed above, functional language must be considered. Thus, claim 39 is allowable.

The present amendment was not earlier presented because the applicant believed that the claims were allowable. The present amendment does not raise any new issues or require any further searching on the part of the Examiner. The present amendment is necessary to more clearly define claims 1, 18, and 39 and to rewrite claims 2, 7-10, 19-20, 22-24, 40, and 42-43 in independent form as suggested by the Examiner. The present amendment places the application in a condition for allowance and is believed to be clearly appropriate.



In view of the foregoing, it is respectfully requested that the amendment be entered and the application allowed.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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